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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,936	12/10/2001	Gilles Bos	33900-90PUS	4569

7590

11/17/2004

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EXAMINER
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BLANCO, JAVIER G

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/009,936

Applicant(s)

BOS ET AL.

Examiner

Javier G. Blanco

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 15, 2004 has been entered.

### *Drawings*

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the **“cylindrical peripheral surface being uncovered by any portion of the implant except in said connection zone”** (see claim 9, lines 10-11) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the

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renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

*Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 9 and 2-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claim 9, newly added claim limitation **"cylindrical peripheral surface being uncovered by any portion of the implant except in said connection zone"** (see claim 9, lines 10-11) is not shown, disclosed, or described in the specification and/or Figures. As shown in Figures 1A-1C, the "cylindrical peripheral surface" is posteriorly covered by the "posterior optical surface 26" and anteriorly covered by the "anterior optical surface 24".

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 2-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Regarding claim 9, the language used to disclose the “cylindrical peripheral surface having a diameter D1” renders the claim vague and indefinite. The “cylindrical peripheral surface having a diameter D1” is not well characterized since, from the claim language, an arbitrary line characterizes the diameter of said surface. Claims 2-8 depend on claim 9.

### ***Response to Arguments***

With regards to the 112 2<sup>nd</sup> paragraph rejection, Applicants’ arguments filed October 15, 2004 have been fully considered but they are not persuasive. Applicants argue, “(t)he language simply identifies that the cylindrical peripheral surface has a diameter, as all cylinders do, and that the diameter is called “D1”. Examiner respectfully disagrees. A “cylindrical peripheral surface having a diameter” is not adequately defined in the claims and/or Figures. As noted in the 112 2<sup>nd</sup> paragraph rejection, an arbitrary line characterizes the diameter of said surface. Where is the demarcation or boundary between the “anterior optical surface 24”, the “posterior optical surface 26”, the “radial extensions 30, 32”, and the “cylindrical peripheral surface having a diameter”?

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

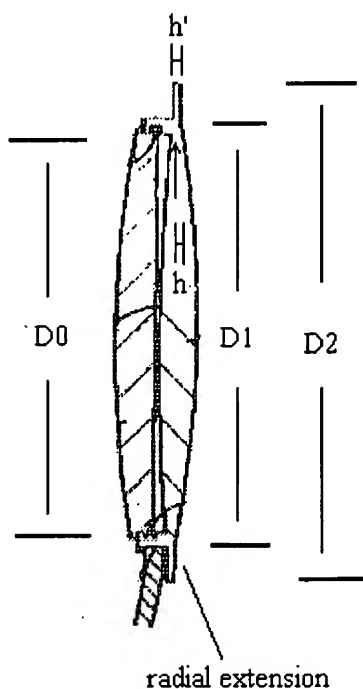
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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8. Claims 2-9 are rejected, as best understood, under 35 U.S.C. 102(b) as being clearly anticipated by Weiser (US 5,713,958 A; cited in previous PTO-892).

As seen in Figure 5 (see Figure 5 below), Weiser discloses an intraocular implant comprising an optical portion having an optical axis, a periphery having at least one connection zone, an anterior optical surface (lens 92), a cylindrical peripheral surface (ring 94) having a diameter and *a length h* (emphasis added) measured parallel to said optical axis, a posterior optical surface (lens 90) defined by a spherical cap, at least one haptic element (haptics 16, 18) having a posterior face and a connection end for connection to a respective connection zone of said periphery of said optical portion, and at least one radial extension (see L-shaped ends formed by ring 94 and lens 90) projection out of said cylindrical peripheral surface.

Each of said radial extensions having an anterior face, a side face, and a posterior face. Said side face of said radial extension disposed on a ruled surface having a diameter D2, said diameter D2 being greater than said diameter D1, said side face having *a length h'* (emphasis added) measured parallel to said optical axis and being substantially equal to said length *h* of the cylindrical peripheral surface. The connection end of the haptic element is connected to the periphery of said optical portion via said anterior face of said radial extension outside said anterior optical surface of said optical portion. Each radial extension constitutes a step formed by the offset between said posterior optical surface of said optical portion and said posterior face of each said haptic element. Each said side face of each said radial extension forms a square-edged portion with said posterior face of said radial extension. The anterior optical surface is bounded by a circle having a diameter D0 that is less than the diameter D1.

**FIG. 5**

### *Response to Arguments*

9. Applicant's arguments filed October 15, 2004 have been fully considered but they are not persuasive.

a. Applicants argue that the IOL of Weiser does not have an unitary structure. Examiner respectfully disagrees. "Unitary" is defined (see [www.onelook.com](http://www.onelook.com) for the definitions from several dictionaries) as: "based on or characterized by one or more units", "having the nature of a unit, whole", "of or relating to a unit". The IOL of Weiser meets any of these definitions.

b. Applicants argue, "(a)s made clear by the amendment above, however, the cylindrical peripheral surface of the claimed invention is uncovered by any other element of the implant, while ring 94 in Weiser is covered by a portion of lens 90 at the periphery thereof." According to

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Applicants' Figures 1A-1C, the "cylindrical peripheral surface" is posteriorly covered by the "posterior optical surface 26" and anteriorly covered by the "anterior optical surface 24".

c. Applicants argue, "it is the length of ring 94 which must be compared to the defined length  $h$  of the cylindrical surface". Examiner respectfully disagrees. The claimed language requires: (i) a cylindrical peripheral surface having a length  $h$ , (ii) a radial extension having a side face having a length  $h'$ , and (iii) length  $h$  being substantially equal to length  $h'$ . First of all, where is the demarcation or boundary between the "anterior optical surface 24", the "posterior optical surface 26", the "radial extensions 30, 32", and the "cylindrical peripheral surface having a diameter"? Second, the claim requires *a length*, which could be broadly interpreted as any portion along the "cylindrical peripheral surface" thickness and any portion along the "radial extension having a side face having a length  $h'$ " thickness. Third, both lengths (i.e., " $h$ " and " $h'$ ") are substantially equal. These limitations are shown in Figure 5 of Weise '958.

### *Conclusion*

10. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

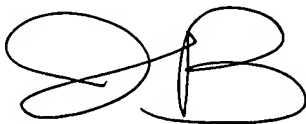
11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Francheschi et al. (FR 2 773 705 A1) and Vinchon et al. (FR 2 821 268 A1).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 571-272-4747. The examiner can normally be reached on M-F (7:30 a.m.-4:00 p.m.), first Friday of the bi-week off.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 703-308-2111. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9306 for regular communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

JGB



November 12, 2004

  
David H. Willse  
Primary Examiner